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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,166	07/10/2003	Randall Eric Swanson	2295-004	4355

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EXAMINER	
ZIRKER, DANIEL R	
ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/618,166

Applicant(s)

SWANSON, RANDALL ERIC

Examiner

Daniel Zirker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 10-23 is/are pending in the application.
- 4a) Of the above claim(s) 10-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 18-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/10/03.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

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1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-5 and 18-23, drawn to a wall patch, classified in Class 428, subclass 63.

II. Claims 10-17, drawn to a method for repairing a hole in a wall, classified in Class 156, subclass 98.

2. The inventions are distinct, each from the other because of the following reasons:

3. Inventions Group I and Group II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a wide variety of adhesive bonding processes such as a label or other adhesive article attached to a suitable substrate.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Cliff Weston on

March 28, 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-5 and 18-23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. The following is a quotation of the second paragraph of 35 U.S.C. § 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-5 and 18-23 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, a substantial number of informalities such as in several instances the lack of antecedent basis and the like are present in the claims; the Examiner will attempt to point out as many as possible but others may well exist and applicant is encouraged to correct these as best as possible. In claim 1 and elsewhere, it is suggested to use "sheet" in place of the vague, indefinite and confusing "body" now presently found throughout the claims. In claims 1 and 18, there is a lack of antecedent basis for "a lower

surface of the body" in line 2 of claim 1 and "the upper surface of the body" in line 3. It is suggested in both claims 1 and 2 that the second line of the claims should read "a substantially planar sheet having an upper and an opposing lower surface" or similar language thereto. In claim 3, line 2, "outward" should be --upper--. In claim 19, line 2, the phrase "one or more edges of the body" lacks antecedent basis and in line 3 the word "mate" should be --bonded to-- or the like. In claim 21, line 2, the phrase "center reinforcement" lacks any sort of structural relationship with the wall patch, i.e. "attached thereto" or the like. In claims 22 and 23 it appears improper to utilize "patch" in the second line of each claim when what is being claimed is a wall patch.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

9. A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 4 and 18 are rejected under 35 U.S.C. § 102(b) as being anticipated by Owens et al. Note particularly the Abstract, column 1 line 58 - column 2 line 16, column 2 lines

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51-59, column 3 lines 11-15, lines 25-30, column 4 lines 19-24. The reference clearly discloses the claimed multilayer laminate in which a polypropylene sheet or layer (column 3, lines 11-13) having on one outer surface a suitable layer of pressure sensitive adhesive for affixing the patch to the desired substrate is disclosed and on the opposing outer surface the patch is ready to be painted with the same paint used on the wall section (column 4 lines 20-24), which is substantially all these claims require.

11. (e) The invention was described in (1) an application for patent, published under Section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1, 4 and 18 are rejected under 35 U.S.C. § 102(e) as being anticipated by Hoffmann, Sr. -949. Note particularly the Abstract, column 2 lines 45-58, column 3 line 65 - column 4 line 12, column 4 lines 27-49, column 5 lines 26-37, lines 50-63. This reference is substantially similar to Owens et

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al., disclosing, in certain embodiments, a polypropylene sheet 12 (column 4 lines 46-48) having on one outer surface a suitable pressure sensitive adhesive, while its opposing outer surface is adapted to receive a curable repair compound, e.g. paint or the like.

13. Claims 2, 3, 5, and 19-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Owens et al. or Hoffmann, Sr. -949, each taken individually, or alternatively as evidence of the state of the art in view of Swallow for claims 2, 3, and 19, for claims 5 and 20 in view of the FASSON trade publication, and for claims 21-23 in view of Estrada. Owens et al. and Hoffmann, Sr. are again relied upon substantially as set forth above, each teaching a variety of repair patches for covering holes in a wall and the like. With respect to such parameters as the presence of a textured outer surface or having the patch when painted being capable of being blended into the wall surface note also that applicant admits in his specification at page 1 lines 25-28 and page 2 lines 3-4 that such elements as the presence of a textured coat and having the repair area painted to match the color of the surrounding wall area are well known in the art. Alternatively, as evidence of the state of the art, Swallow discloses (note particularly column 2 lines 34-49, column 3 line 66 - column 4 line 12, column 4 lines 37-42, column

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6 line 45 - column 7 line 4, and column 7 line 66 - column 8 line 13) these elements, as well as also the presence of a sawtoothed outer pattern and the like (column 7 line 66 - column 8 line 2). With respect to the presence of a biaxially oriented three ply polypropylene film, note as evidence of the state of the art in polypropylene films (which are each taught by the primary references) the FASSON trade publication which teaches the presence of a suitable permanent adhesive on one surface of the polypropylene sheet and the Examiner further believes that biaxially orientation is extremely well known in the polymeric laminate and patch film art. Finally, with respect to evidence of the state of the art for claims 21-23, note that a suitable center reinforcement such as a rigid metal patch is clearly taught by both Estrada and Hoffmann, Sr. -017. Additionally, the Examiner believes that one of ordinary skill would have more than ample motivation to turn to each of these secondary teaching and thereby either form, or clearly render obvious, the claimed invention. Other parameters that are not either expressly or inherently disclosed are each believed to be at most obvious optimizations to one of ordinary skill, in the absence of unexpected results.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also

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Bergeron et al. and the parent allowed divisional to Swanson.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

April 4, 2005

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1800

1700

Daniel Zirker